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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,725	07/31/2001	Eduardo Gomez Canon	023693-00001	1249
4372	7590	06/15/2006	EXAMINER	
ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			CHARLES, DEBRA F	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/917,725

Applicant(s)

CANON, EDUARDO GOMEZ

Examiner

Debra F. Charles

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/9/2006 has been entered.

***Response to Amendment***

1. Claim 11 has been amended.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1 and 11 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11 - 15 and 19-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Drummond et al. (2001/0014881A1).

Re claim 11. Drummond et al. discloses a method of executing a plurality of transaction types with a smart card(para 0003, 0059, 0086), said method comprising at least the steps of:

executing a first transaction type by,

inserting said smart card into a first receptacle of a first card processing

receiving a first transaction decision based on information of said first

obtaining said smart card from said first card processing unit, and

transaction type(para 0003, 0059, 0086),

executing a second transaction type by,

formulating a desired second transaction type,

availing information of said second transaction type stored on said smart

card(para 0003, 0059, 0086, 0143),

authorizing the execution of said second transaction type, and

obtaining said smart card, and executing a third transaction type by,  
formulating a desired third transaction type,  
inserting said smart card into a second receptacle of a second card  
processing unit(para 0003, 0059, 0086, 0143),  
viewing information of said third transaction type on a display, inputting an  
authenticating code(para 0003, 0059, 0086, 0143, 0144),  
transmitting said information of said third transaction type and said  
authenticating code to a server,  
receiving a confirmation of said desired third transaction type, and  
retrieving said smart card from said second processing unit(para 0003,  
0059, 0086, 0143, 0144, 0145).

Re claim 12. Drummond et al. discloses wherein the steps of executing  
said first transaction type further comprises the steps of  
describing a basis for executing said first transaction type, and  
receiving said first transaction decision based on information of said first  
transaction type and said basis for executing said first transaction type(para  
0003, 0059, 0086).

Re claim 13. Drummond et al. discloses comprises the step of:  
executing said first transaction type wherein said first transaction type is a  
medical transaction(para 0145).

Re claim 14. Drummond et al. discloses wherein the steps of executing  
said first transaction type further comprises the step of:  
availing said smart card to an health care service provider(para 0145).

Re claim 15. Drummond et al. discloses the steps of executing said first  
transaction type further comprises the step of:  
obtaining said smart card from said first card processing unit having  
updated information of said first transaction type(para 0003, 0059, 0086).

Re claim 19. Drummond et al. discloses comprising the steps of:  
executing said second transaction type wherein said second transaction  
type is a financial transaction(para 0003, 0059, 0086, 0156, 0157).

Re claim 20. Drummond et al. discloses the steps of executing said second  
transaction type further comprises the step of:

passing said smart card through a magnetic medium reader such that said information of said second transaction type stored on said smart card is read by said magnetic medium reader(para 0147).

Re claim 21. Drummond et al. discloses the steps of executing said second transaction type further comprises the step of:

formulating said desired second transaction type, wherein said desired second transaction type is to purchase a consumer product or service(para 0144, 0145).

Re claim 22. Drummond et al. discloses the steps of executing said second transaction type further comprises the steps of:

inserting said smart card in an opening of an Automatic Teller Machine (ATM), inputting a Personal Identification Number from an input unit of said ATM(para 0143, 0144),

selecting said desired second transaction type from a plurality of second transaction types, commencing said desired financial transaction type, and retrieving said smart card from said ATM(para 0142, 0143, claim 1, 6,7,8,30).

Re claim 23. Drummond et al. discloses executing said third transaction type wherein said third transaction type is an e-commerce transaction(para 0141, 0142).

Re claims 24 and 25. Drummond et al. discloses the steps of executing said third transaction type further comprises the step of:  
transmitting said information of said third transaction type and said authenticating code to a server configured on the Internet or the WWW.  
And formulating said desired third transaction type wherein said desired third transaction type is to purchase a consumer product or service through the Internet or WWW(para 0162, 0163, 0197).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



5. Claims 1,3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Younger and Gangi(US 2001/0045454 A1).

Re claim 1: Younger disclose a smart card for executing a plurality of transaction types, said smart card (Abstract) comprising:

a card substrate(Fig. 1 and 2);

a microchip embedded in said card substrate(Abstract, Fig. 1 and 2), and

a magnetic medium on said card substrate(col. 3, lines 15-40),

Younger does not disclose wherein at least one of said microchip and said magnetic medium contains information for executing the plurality of independent transaction types being coordinated through a plurality of vendors of service and products, plurality of transaction types includes a medical transaction, a financial transaction, and an e-commerce transaction. However, Gangi disclose general use of electronic smart cards for the storage of information pertaining to electronic commerce and consumer identification, and a method and apparatus for warehousing(storing) and retrieval of information pertaining to credit cards, debit cards, identifications cards and other selected data. It would be obvious to one of ordinary skill in the art to modify the invention of Younger based on the teachings of Gangi. The motivation to combine these references is to effectively and efficiently facilitate transactions, however, the wording of claim does not indicate transactions, but the Gangi reference does.

Re claim 3. Younger disclose said microchip contains medical information for executing said medical transaction(col. 1, lines 15-40).

Re claim 4. Younger disclose wherein said medical information includes medicinal prescriptions(col. 1, lines 15-40).

Re claim 5: Younger disclose said microchip contains e-commerce information for executing said e-commerce transaction on the Internet or the World Wide Web (WWW)(col. 1, lines 15-40),

Re claim 6: Younger disclose wherein said magnetic medium contains financial information for executing said financial transaction (col. 1, lines 15-40).

Re claim 7. Younger disclose a graphical depiction of a proprietor placed on said smart card(col. 3, lines 15-30).

Re claim 8. Younger disclose said microchip contains security information for prohibiting unauthorized access to said information contained on said smart card(col. 5, lines 25-55).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Younger, Gangi(US 2001/0045454 A1) and Merkle et al.(5157726).

Re claim 9. Younger and Gangi(US 2001/0045454 A1)disclose the invention except security information includes a personal information in the form of a digital signature. However, in col. 4, lines 45-65, thereof Merkle et al. disclose digital signature as a form of secure personal information used in conjunction with a smart card. It would be obvious to one of ordinary skill in the art to modify the invention of Younger based on the teachings of Merkle et al. The motivation to combine these references is to effectively and efficiently enforce more secure smart card applications.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Younger, Gangi(US 2001/0045454 A1) and Cooreman et al.(6698661).

Re claim 10. Younger and Gangi(US 2001/0045454 A1) disclose the invention except said microchip contains bonus rewards information based on the execution of said plurality of transaction types. However, in col. 1, lines 1-55, thereof Cooreman disclose a chip card that has a counter to keep track of loyalty points customer earns from various transactions. It would be obvious to one of ordinary skill in the art to modify the invention of Younger based on the teachings of Cooreman et al. The motivation to combine these references is to effectively and efficiently enforce more secure smart card applications.

4. Claims 16, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond et al. and Nichols et al.(2003/0055652).

Re claims 16, 17 and 18: Drummond et al. disclose the steps of executing said first transaction type further comprises the step of:

accessing said health care service provider through an Internet Health Vertical Portal (IHVP), wherein said IHVP is configured on the Internet or the WWW, and scheduling an appointment with said health care service provider via said IHVP. However, in para. 0161, Nichols et al. disclose an interactive internet portal site for bil-lateral communications. It would be obvious to one of ordinary skill in the art to modify the invention of Drummond et al. based on the teachings of Nichols et al. The motivation to combine these references is to effectively and efficiently enhance communications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (571) 272 6791. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (571) 272 6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Debra F. Charles  
Examiner  
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